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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,838	12/11/2006	Gerhard Schwenk	SCHW3002/JEK	5049

23364 7590 10/26/2009
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EXAMINER

TRAIL, ALLYSON NEEL

ART UNIT	PAPER NUMBER
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2876

MAIL DATE	DELIVERY MODE
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10/26/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,838	Applicant(s) SCHWENK ET AL.	
	Examiner ALLYSON N. TRAIL	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/6/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The Information Disclosure Statement filed on April 6, 2006 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Double Patenting

3. Claims 1-10 and 13-43 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8, 10, 12-17, 20, 21, 23, 24, 27-29, 31, 32, 36, 38-40, 42, and 45 of copending Application No. 10/575,080. Although the conflicting claims are not identical, they are not patentably distinct from each other. Both pending applications claim a value document comprising a value document substrate and at least three different feature substances for checking the value document.

The Examiner believes that the scope of claim 36 of the present application, and claims 1, 4, 18, and 24 of the '337 patent are almost identical but differ only in terminology and/or phrasing of terminology.

Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilize the teachings of claims 1, 4, 18, and 24 of the '337 patent and modify the terminology and the phrasing of the claims.

The obviousness-type provisional double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. §1.32(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. §1.78(d)

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

4. Claim 1 is objected to because of the following informalities:

Re claim 1, line 4: replace, "substances are provided" with --substances provided--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1-15, 21-41, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahlers et al (6,530,527), hereinafter Ahlers.

With respect to claims 1, 7, 10, 12, 15, 23-26, 32, 33, 35, and 36 Ahlers discloses a value document 1 (bank note), including a value document substrate and at least three different feature substances (shown in figure 8) for checking the value document, wherein the value document has a first feature substance, and second and third feature substances provided on the value document substrate in a printing ink jointly, the second feature substance comprising a luminescent substance (luminous dyes 12) and the third feature substance comprising by a material absorbent in a selected spectral range (figure 11, 13). See the abstract, column 1, lines 10-16 as well as column 4, lines 53-67. Though only 3 substances are shown in the figures, Ahlers refers does not limit the number of substance, therefore clearly there could be a forth substance, different from the first three.

With respect to claims 2, 3, and 11, the figures show the first features substance being incorporated into the volume of the substrate of the value document as well as being distributed substantially uniformly within the volume of the value document substrate.

With respect to claims 4-6 and 41, Ahlers discloses in column 1, lines 13-16, the third feature substance absorbing in the infrared spectral range. Lines 13-16 further discuss the substance being substantially colorless or having only weak inherent color in the visible spectral range. The range disclosed in lines 13-16 would include the spectral range recited in claim 6.

With respect to claims 8 and 13, Ahlers teaches in column 3, lines 21-27, that the third feature substance comprises a doped semiconductor material or metal oxide.

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With respect to claim 9, Ahlers discloses in column 4, lines 43-52 the third feature substance being present in the printing ink in particle form with an average particle size smaller than 50 nm.

With respect to claim 14, see Ahlers' teachings above with regards to claim 1 and as well as Ahlers' claim 1.

With respect to claim 21, Ahlers discloses in column 6, lines 37-40, the document substrate comprising a printed cotton paper.

With respect to claim 22, Ahlers discloses in column 1, lines 18-21, the document comprise a printed plastic film.

With respect to claims 27-30, 38, and 39, see Ahlers' teachings in the abstract as well as Ahlers' claim 15.

With respect to claims 31 and 34, see Ahlers' teachings disclosed in Ahlers' claim 1.

With respect to claims 37 and 43, see Ahlers' column 3, lines 11-35.

With respect to claim 40, Ahler discloses in column 9, lines 37-43, using a laser diode.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlers in view of Bratchley (6,155,605).

Ahlers' teachings discussed above fail to specifically teach the substance being incorporated in the value document substrate in the form of a coding.

With respect to claims 16-18, Bratchley discloses in column 1, lines 49-60 the feature substance being incorporating in the value document substrate in the form of a coding.

With respect to claims 19 and 20, Bratchley discloses in column 2, lines 5-11, the coding being a bar code, which can represent information about the value document.

In view of Bratchley's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the substance in the value document in the form of a coding as is taught by Bratchley, in the value document disclosed by Ahlers. One would be motivated to use a coding as codings are known to both provide a security feature as well as store information which can be decoded.

9. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlers in combination with Bratchley and in further view of Henderson et al (2002/0188845), hereinafter Henderson.

Ahlers' teachings in combination with the teachings of Bratchley are discussed above. The combination however fails to specifically teach the code being in an encrypted form.

With respect to claim 42, Henderson discloses in paragraph 0046, a value-bearing document including an encrypted bar code.

In view of Henderson's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt as is taught by Henderson, the bar code taught by Bratchley. The bar code is placed on a document in order to provide security for the document. Therefore, one would be motivated to additionally encrypt the bar code so that the data encoded in the bar code is also protected from unauthorized users.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Lee et al (6,786,954).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**allyson.trail@uspto.gov**].

All Internet e-mail communications will be made of record in the application file.
PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record

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includes a properly signed express waiver of the confidentiality requirements of 35

U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published

in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG

89.

/Allyson N. Trail/
Allyson N. Trail
Patent Examiner
Art Unit 2876

October 23, 2009